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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,842	02/12/2001	Thomas J. Blakemore	D-2958	7727

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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,842

Applicant(s)

BLAKEMORE ET AL.

Examiner

LOVERING

Group Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on AUG. 1, 2002.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 23-47 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 23-25, 28, 30 AND 32-46 is/are rejected.
- ☒ Claim(s) 26, 27, 29, 31 AND 47 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit 1712

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 23-25, 28, 33-35, 38-40, 42, 44 and 45 are rejected under 35 U.S.C. § 102(b) as being anticipated by Jorda et al. 5,585,050, esp. Example 1, noting also column 5, lines 3-13. The recitation of a new or different intended use does not render an old composition, such as the microcapsules of Jorda et al., new or patentable. See In re Thuau, 1943 C.D. 390; 554 O.G. 14; and In re Zierden, 411 F. 2d 1325; 162 USPQ 102.

3. Claims 23-25, 28, 30, 33-38 and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell et al. 5,741,433 in view of Jorda et al. above. Mitchell et al. (column 1, lines 5-15) disclose a controlled (slow) release additive for use in water treatment systems, such as cooling towers (which are open circulating cooling water systems), said control-release additive comprising a water-soluble core containing at least one water treatment chemical and a polymer coating material encapsulating said core, and Mitchell et al. (column 1, lines 28-33) suggest the encapsulation of microcides, as well as corrosion inhibitors, pH agents and buffers. While Examples 1, 3 and 4; the Abstract; and column 3, line 35 - column 6, line 41 of Mitchell et al. may relate primarily to corrosion inhibitors, pH agents etc., it would have been obvious to one skilled in the art at the time applicants' invention was made to use the

Art Unit 1712

dimethyldidecyl ammonium chloride and EVA copolymer of Jorda et al. above as the intended core material and wall material, respectively, in Examples 3 or 4 to produce the microcide-containing microcapsules suggested by Mitchell et al. and then use them in a cooling tower.

4. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al. in view of Jorda et al. as applied to claims 23-25, 28, 30, 33-38 and 46 above, and further in view of Hiestand et al. 3,242,051. While the foregoing combination of Mitchell et al. and Jorda et al. doesn't disclose the use of ethyl cellulose, it would further have been obvious to one skilled in the art at the time applicants' invention was made to use the ethyl cellulose of Hiestand et al. (column 3, line 35; and Example 4) as a supplemental wall material in the foregoing combination of Mitchell et al. and Jorda et al., since Hiestand uses two layers of wall material and contemplates coating antibacterials (column 2, lines 34-39).

5. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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060 43 & 40 now
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Art Unit 1712

6. Claim 43 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the original disclosure do applicants specifically disclose any copolymer of ethylene and acrylate.

7. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 38-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending application Serial No. 09/539,914. Although the conflicting claims are not identical, they are not patentably distinct from each other because the stated claims herein read on, or at least overlap,

Art Unit 1712

claims 1-8 of the '914 application, because the stated claims herein use the same wall material and the same (or overlapping) core materials and the statement of intended use in the preamble is not a difference in substance.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 26, 27, 29, 31 and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record doesn't disclose or fairly suggest the controlled-release additive composition of claims 26, 27, 29 and 31 or the method of releasing the additive composition in an open circulating cooling water system of claim 47.

11. Applicants' arguments filed August 1, 2002 have been fully considered but they are not deemed to be persuasive. As above, Mitchell et al. (column 1, lines 28-33) do suggest encapsulation of microbiocides. Disclosure in a reference is not limited to its specific illustrative examples, but must be considered as a whole to ascertain what would be realistically suggested thereby to one of ordinary skill in the art. See In re

Serial No. 09/781,842

-6-

Art Unit 1712

Uhlig, 153 USPQ 60; 853 O.G. 14. Hiestand et al. (column 2, lines 26 et sequa) contemplate coating particulate materials for widely diversified fields of use, including antibacterials.

12. The references listed on the attached Form PTO-1449 (two sheets) are cumulative to the references applied herein, and/or further show the state of the art.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
October 4, 2002

Richard D. Lovering
RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP 1200 1700